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| 09/808,329 | 03/14/2001 | Alan Taylor | 55,085-CIP (18102) | 3854 |

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EXAMINER

ASHBURN, STEVEN L

| ART UNIT | PAPER NUMBER |
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3714

18

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,329

Applicant(s)

TAYLOR ET AL.

Examiner

Steven Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 14-24 and 26-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 14-24 and 26-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 17.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 8, 2004 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14, 15, 19-23, 26, 27, 31, 33, 52, 58 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Goodson et al., US 5,927,716 (Jul. 27, 1999).

Goodson discloses lottery game system in which game instructions are announced subsequent to distribution of the tickets to prevent stockpiling of tickets and to encourage the purchase of more tickets. *See abstract.* The game instructions notify the players as to which game areas in a ticket playing field they must unmask in order to win the interactive game of chance. *See id.* To safeguard against stockpiling of old tickets, play areas that are not unmasked in accordance with the play instructions automatically invalidate the tickets. *See id.* As described below, Goodson teaches each and every feature of the listed claims.

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Claims 14 and 26. The features of the claimed invention taught or suggested by Goodson are described below.

- a. Receiving a lottery ticket comprising a plurality of concealed playing game pieces disposed in at least one array comprising a plurality of panels. *See fig. 1, 3; col. 4:49-5:21.*
- b. Receiving a first drawing designation that designates some, but not all of the panels as a playing panel for the game. *See id.*
- c. Revealing a plurality of playing game pieces disposed on the ticket, wherein the plurality of pieces includes those concealed piece that are disposed beneath the designated panels. *See id.*
- d. After receiving the lottery ticket, receiving a first random selection of winning game pieces, wherein the first random selection of winning pieces is external to the lottery ticket. *See id.*
- e. Determining whether the lottery ticket is a winner. *See id.*

Claims 15: At least three panels are selected as the playing panel for each game. *See id.*

Claims 19 and 27. The plurality of game pieces are revealed by removing a removable material disposed over the playing game pieces. *See id.*

Claim 20, 31 and 33. Designating a unique sub-population of game pieces selected form a total population of game pieces so that each unique sub-population is disposed as the playing game pieces, authenticating the validity of the ticket; and awarding a prize for each winning ticket. *See fig. 3, 4:33-37.*

Claim 21. The number of winning game pieces selected is equal to the number of game pieces revealed. *See col. 4:1-11, 5:1-9.*

Claim 22. Having some but not all of the winning game pieces selected from each of the unique subpopulations of playing game pieces designated for each of the panels selected. *See id.* In particular, Goodson describes having winning game pieces selected from a subpopulation of red play areas.

Claim 23. The number of winning game pieces are selected from each of the unique subpopulations is equal to the number of playing pieces revealed in each of the corresponding panels. *See id.* In particular, Goodson describes having winning game pieces selected from a subpopulation wherein the subpopulation comprises all of the red play areas on the ticket.

Claim 52. A second drawing event designation wherein the event designation designates a second subset of panels for play, wherein the second subset is distinct from the first event designations. *See col. 3:3-18.*

Claim 58. Receiving a second drawing designation, after receiving the lottery ticket, receiving a second random selection of the winning game pieces wherein the second selection is external to the game piece, determining if the lottery ticket is a winner based on the first random selection, determining if the lottery ticket is a winner based on the second random selection, receiving a prize if the lottery ticket is a winner. *See fig. 3, 3a; col. 2:37-3:3-27, 4:48-21.*

Claim 59. Second random selection is external to the game ticket. *See 2:62-64, 4:61-5:9.*

Claims 34-36, 47, 49 and 54-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Maksymec, US 5,265,880 (Nov. 30, 1993)

Maksymec discloses a bingo game is played over a long duration of time. *See abstract.* A fixed number of bingo numbers are drawn from the pool of numbers at the beginning of the game and are posted or displayed for players to see. *See id.* Players may acquire cards at any time during the play of the game and compare the cards with the winning numbers to see if the card is a winning card. *See id.* The card faces are invisible to the player upon purchase, and can be preprinted, printed by a random generator on demand, or be displayed on video screens. *See id.* The features of the claimed invention taught or suggested by Maksymec are described below.

Claims 34 and 49. The features of the claimed invention taught or suggested by Maksymec are listed below.

- a. Receiving a game ticket including a substrate having an obverse and reverse side. *See col. 4:6-26.* In particular, Maksymec discloses a physical card. Cards inherently possess an obverse and reverse side.
- b. Plurality of playing pieces which are disposed on the obverse side of the lottery ticket in at least one array comprising a plurality of panels, each of the panes comprising a number of playing game pieces. *See col. 2:59-65.*
- c. Removable material having a surface that is disposed over, so as to conceal the plurality of playing game pieces wherein a plurality of unique indicia is deposited on the surface of the removable material so that each of the plurality of unique indicia corresponds to only one of the plurality of panels. *See id.*
- d. Said ticket usable in conjunction with at least two types of drawing events. *See col. 3:34-59.*

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e. Receiving a first drawing event designation wherein the event designation includes a designation of a subset of the plurality of panels to be used in game play. *See col. 2:24-28, 2:59-64, 3:18-34.*

f. Receiving a selection of a plurality of winning game pieces after a participant has received a game ticket wherein the selection of the winning game pieces is external to the game ticket. *See id.*

Claim 35. The plurality of game pieces comprises a series of integers. *See col. 1:27-34, 3:14-34.*

Claim 36. The number of playing pieces in the plurality of panels is at least three. *See col. 2:59-63.*

Claim 47. Selecting a plurality of winning game pieces. *See col. 3:37-47.*

Claim 54. Receiving a selection event designation that designates at least one event to select the plurality of winning game pieces. *See col. 2:34-58.*

Claim 55. A second drawing event designation wherein the event designation designates a second subset of panels for play, wherein the second subset is distinct from the first event designations. *See col. 4:48-67.* In particular, the game may be played in conjunction with other games.

Claim 56. A selection device to select a plurality of winning game pieces. *See col. 3:60-61.*

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Claim 57. Providing a selection event designation designating an event to select winning game pieces. *See col. 3:14-18*. In particular, Maksymec designates a time event to during which winning game pieces are selected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maksymec, US 5,265,880 (Nov. 30, 1993) in view of Bruin et al., US 5,836,816 (Nov. 17, 1998)

Claims 1 and 45. The features of the claimed invention taught or suggested by Maksymec are listed below.

- a. Substrate having an obverse and reverse side. *See col. 4:6-26*. In particular, Maksymec discloses a physical card. Cards inherently possess an obverse and reverse side.
- b. Plurality of playing pieces which are disposed on the obverse side of the lottery ticket in at least one array comprising a plurality of panels, each of the panels comprising a number of playing game pieces. *See col. 2:59-65*.
- c. Removable material having a surface that is disposed over, so as to conceal the plurality of playing game pieces wherein a plurality of unique indicia is deposited on the surface of the removable material so that each of the plurality of unique indicia corresponds to only one of the plurality of panels. *See id.*

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- d. Said ticket usable in conjunction with at least to two types of drawing events. *See col. 3:34-59.*
- e. A playing life for the lottery ticket, wherein the playing life includes a plurality of drawing events where the lottery ticket can be played. *See col. 3:2-55; 4:55-65.*
- f. A drawing event designation. *See fig. 1*
- g. A random selection device wherein the random selection device selects a plurality of winning game pieces. *See fig. 1; col. 2:21-33.*

As listed above, Maksymec describes all the features of the claims except placing instructions for the at least two types of events on the ticket.

It was within the ordinary skill in the art at the time of the invention to place instructions for at least two types of events on a lottery ticket. For example, Bruin discloses an analogous lottery game ticket containing instructions for two types of lottery games to explain the steps required to play each game. *See fig. 2.* Thus, it would have been obvious to an artisan at the time of the invention to modify Maksymec, wherein a ticket allows a player to participate in two types of lottery games, to add the feature of placing instructions for the at least two types of events on the ticket and thereby explain the steps required to play each game. As suggested by the ordinary knowledge of an artisan, providing instructions improves a system by explaining the proper steps for its use and thereby prevents confusion and errors amongst users.

Claim 46. Maksymec discloses providing means for authenticating a game ticket by providing a batch control number. *See col. 2:65-3:14.*

Claims 16-18, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodson.

Goodson does not specifically describe selecting three or four panels for the game. Regardless, Goodson teaches varying the rules of the game including number of panels to reveal. *See col. 2:62-67, 4:23-32, 4:61-5:21*. Hence, it would have been an obvious design choice for an artisan at the time of the invention to modify the lottery system disclosed by Goodson, wherein tickets are used to play different games having different rules, to selecting three or four panels for a game in accordance with a particular game's rules. As suggested by Goodson, modifying the rules for selecting panels enhances the revenue for the game operator by ensuring that players do not stockpile tickets. *See col. 3:19-33*.

Claims 24, 28, 32, 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodson in view of Fienberg, U.S. 4,943,090 (Jul. 24, 1990).

Claims 24, 28 and 32. Goodson does not disclose determining a ticket to be a winner if the combination of winning game pieces matches a combination of revealed playing game pieces so that at least three of the pieces adjoin horizontally, vertically or horizontally. Regardless, determining a winner based on whether the selected pieces adjoin horizontally, vertically or horizontally merely describes a bingo-type game. Bingo games are a notoriously popular form of lottery. For example, Fienberg discloses an analogous lottery system in which a ticket is determined to be a winner if the combination of winning game pieces matches a combination of revealed playing game pieces so that at least three of the pieces adjoin horizontally, vertically or horizontally. *See fig. 1-5; col. 3:3-12*. In view of Fienberg, it would have been obvious to an artisan at the time of the invention to modify Goodson, wherein different games use different game rules, to add the feature of determining a ticket to be a winner if the combination of winning game pieces matches a combination of revealed playing game pieces so that at least three of the pieces adjoin horizontally, vertically or horizontally. As suggested by Fienberg, the

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modification would enhance the game by allowing multiple combinations of panels to win and thereby increase the entertainment provide to players. *See col. 5:1-7.*

Claim 50. Fienberg describes multiple winning groups of symbols on a game card wherein he prize increased in value as a function of the number of winning lines. *See fig. 3, 5; col. 2:47-5; 4:37-45, 4:61-67.*

Claim 51. Fienberg discloses increasing the value of the prize as the function of the number of winning lines. *See fig. 3, 5; col. 2:47-5; 4:37-45, 4:61-67.*

Claims 37-44 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maksymec in view of Leake, U.S. 5,624,119 (Apr. 1997).

Claims 37 and 38. Maksymec does not describe selecting three or four panels for the game. Notably, only the preferred embodiment requires a 5x5 array requiring the selection of five panels for the game. Leake discloses an analogous game tickets having a variety of configurations and requiring different numbers of selections of game panels. *See fig. 1-5, 4:16-21.* The reference teaches that it is a matter of design choice to vary the number of panels used and selected in a bingo-type game. *See id.* In view of Leake, it would have been obvious matter of design choice for an artisan at the time of the invention to modify the game ticket described by Maksymec to add the features of selecting three or four panels for the game in order to vary the numbers of versions and thereby enhance player's interest in the games.

Claim 39. Leake describes revealing all of the plurality of game pieces disposed under a combination of playing panels, said combination of panels including some, but not all of the panels,

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wherein the combination of panels is unique to each drawing event of a plurality of drawing events. *See fig. 13, 14; col. 4:384-48; 7:9-61.*

Claims 40-43. Leake describes a plurality of game pieces disposed in three or four panels are revealed where the panels are consecutive. *See fig. 13, 14; 7:9-8:4*

Claim 44. Leake describes a free space. *See col. 11:4-8.*

Claim 48. Leake describes awarding a prize based on the number of winning lines on a ticket. *See fig. 14-16; col. 7:62-8:10, 176:48-17:39.*

Claims 34 and 60-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodson in view of Fujita, U.S. 4,725,077 (Feb. 16, 1988).

Claim 60. Goodson discloses all the features of the claimed game except winning game pieces are selected in multiple drawings. Regardless, Fujita discloses an analogous game in which, over the playing life of a ticket, game pieces are selected in multiple drawings. *See col. 1:60-2:5.* In view of Fujita, it would have been obvious to an artisan at the time of the invention to modify Goodson, wherein tickets having a limited lifetime are played as part of a television promotion, to add the feature of selecting winning game pieces in multiple drawings. As suggested by Fujita, the modification would enhance the promotional effect of the game by motivating players to pay attention for each drawing. *See id.*

Claims 61 and 63. Fujita discloses multiple drawings take place within the life of a game ticket. *See id.*

Claims 62 and 64. Fujita discloses the selection of winning game pieces being received through multiple drawings. *See id.*

Claim 65. Fujita discloses multiple drawings take place within the life of a game ticket. *See id.*

Response to Arguments

Applicant's arguments with respect to claims 1, 14-24 and 26-65 have been considered but are moot in view of the new ground(s) of rejection.

Prior Art, Not Relied On

The following prior art of record is not relied upon but is considered pertinent to applicant's disclosure:

- a. U.S. 6,457,714 discloses a lottery game in which panel values are values a selected external to a ticket.
- b. U.S. 5,217,258 discloses a lottery ticket having two distinct games.
- c. U.S. 6,656,044 discloses a bingo-type game offering two separate games and games wherein values a randomly selected external to a ticket.
- d. U.S. 2002/0053597 discloses a lottery ticket with instruction printed thereon.
- e. U.S. 6,616,531 discloses a lottery ticket having rules for two different games printed thereon.
- f. U.S. 6,305,687 discloses a lottery game in which panel values are values a selected external to a ticket.
- g. U.S. 5,772,511 discloses a lottery system having offering two distinct games.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.



MARK SAGER
PRIMARY EXAMINER